

REMARKS

Claims 23-44 are pending in this application. By this amendment, claim 44 is cancelled, claims 23, 32, 37, and 41 are amended to more precisely recite the novel features of the present application, and claims 26, 27, 30, 31, 32, 34, 38, and 41 are amended to correct informalities. No new matter is introduced. Support for the amendments can be found at least in original claim 32, Figures 8A-B, 9B-C, 19A-C, and 43A-E, and their corresponding text. Reconsideration and prompt allowance of the claims is respectfully requested.

Reissue Application

Please note that an assignment was filed on May 31, 2006. Filed herewith is a reissue declaration of the inventor accompanied by the written consent of all assignees.

Double Patenting Rejection

Claims 23-44 are provisionally rejected based on the non-statutory obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent RE39,044. Filed herewith is a terminal disclaimer in accordance with 37 C.F.R. §1.321 disclaiming any term extending beyond that of U.S. Patent RE39,044. Withdrawal of the rejection of the claims based on the judicially created doctrine of double patenting is respectfully requested.

Specification Objection

The specification is objected to because of an informality. The specification has been amended to indicate the patent number of the parent application. Withdrawal of this objection is respectfully requested.

Claim Objections

Claims 26, 30, 34, and 41 are objected to because of informalities. Claims 26, 30, 34, and 41 have been amended to remove the informalities. Withdrawal of this objection is respectfully requested.

35 U.S.C. § 112 Rejections

Claims 23-44 are rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Office Action asserts that claims 23, 32, 37, and 41 include new matter that is not supported by the prior patent because these claims recite negative limitations. The negative limitations recited in claims 23, 32, 37, and 41 have been removed. Withdrawal of this rejection is respectfully requested.

Claims 23-31 are rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Office Action asserts that claim 23 does not provide enablement for “modifying at least a portion of said

first coating ... such that a characteristic of said first coating is altered.” This rejection is respectfully traversed. Amended claim 23 recites: “during formation of said pattern, modifying at least a portion of said first coating over-covered by said second coating *by applying energy to said portion of said first coating through an over-covered region of said second coating* such that a characteristic of said first coating is altered,” (emphasis added). The specification provides sufficient description at least in Figures 8A-B, 9B-C, 19A-C, and 43A-E, and their corresponding text to enable one skilled in the art to make and use the invention. Withdrawal of this rejection is respectfully requested.

Claims 27, 31-36, 38, and 44 are rejected under 35 U.S.C. § 112, second paragraph because claims 27, 31, 32, 38, and 44 are vague and indefinite. Claims 27, 31, 32, and 38 have been amended to remove the informalities noted in the Office Action to particularly point out and distinctly claim the novel subject matter. Claim 44 has been cancelled. Withdrawal of this rejection is respectfully requested.

35 U.S.C. § 102 Rejections

Claims 23-44 are rejected under 35 U.S.C. § 102(b) over U.S. patent 4,673,609 to Hill (hereafter Hill). This rejection is respectfully traversed.

Claim 44 has been cancelled, rendering the rejection of this claim moot.

Hill is directed to a unidirectional panel that includes a substrate of transparent or translucent material that is applied to one or both sides a design superimposed on an opaque pattern so that the design on one side of the panel cannot be seen from the other side. However, Hill does not disclose or suggest *applying energy* to a portion of a first coating through an over-covered region of a second coating to alter the characteristic of the first coating. Further, Hill does not disclose or suggest applying such energy *during formation of a pattern*.

In contrast, amended claim 23 recites: “during formation of said pattern, modifying at least a portion of said first coating over-covered by said second coating by applying energy to said portion of said first coating through an over-covered region of said second coating such that a characteristic of said first coating is altered.” As noted above, Hill does not disclose or suggest these features. Therefore, amended claim 23 is allowable over Hill.

Amended claims 32, 37, and 41 recite similar features and are allowable over Hill for the same reason as noted above with respect to claim 23.

Dependent claims 24-31, 33-36, 38-40, and 42-43 are allowable at least because they depend from allowable claims 23, 32, 37, and 41, respectively, and for the additional features they recite.

Withdrawal of the rejection under 35 U.S.C. § 102(a) is respectfully requested.

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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Attachments: Terminal Disclaimer; Consent of assignee & Statement under 3.73(b)